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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,059	03/19/2001	Daniel P. McCune	01-035-US	9010

7590

11/17/2004

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EXAMINER

POPOVICS, ROBERT J

ART UNIT

PAPER NUMBER

1724

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,059

Applicant(s)

MCCUNE ET AL.

Examiner

Robert J Popovics

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-16 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-16 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claims 2-16 and 21-25 are pending.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the structures recited in claim 13 (i.e. cartridge plate, inlet manifold, outlet manifold, etc.) without a horizontal surface, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Claims 2-3,9 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: an inlet, an outlet and cartridge filter bores (i.e., the subject matter recited in claim 4).

Claims 2-16 and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what Applicant intends by the recitation "*multi-round filter housing*" as recited in claims 2-16 and 21-25.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

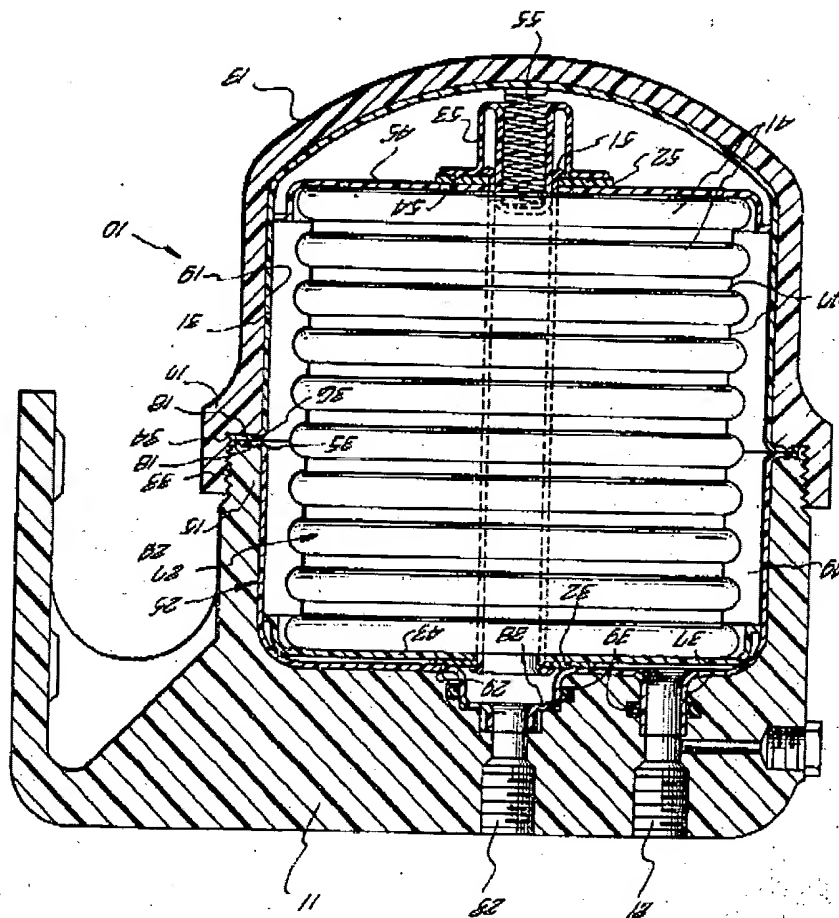
Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-5,10-12,21-25 are rejected under 35 U.S.C. 102(b) as being

anticipated by **Ogden (US 3,727,764)**. See dome 13 and integrated base



assembly 11.

Claims 2-4 and 9-12 are rejected under 35 U.S.C. 102(a or b) as being anticipated by Allegheny Bradford Corporation Brochure. The cartridge plate of this reference is seen to be "integral."

Claims 2-4 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Pall Housing Data Sheet H21. The cartridge plate of this reference is seen to be "integral."

Claims 2-4 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Pall Housing Data Sheet H25. The cartridge plate of this reference is seen to be "integral."

Claim Rejections - 35 USC § 103

Claims 2-4 and 9-12 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Allegheny Bradford Corporation Brochure. If it were established that this reference does not teach integral construction, it would have been obvious to make the components integral. See *In re Larson*, 340 F.2d 965,968; 144 USPQ 347, 349 (CCPA 1965).

Claims 2-4 and 9-12 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Pall Housing Data Sheet H21. If it were established that this reference does not teach integral construction, it would have been obvious to make the components integral. See *In re Larson*, 340 F.2d 965,968; 144 USPQ 347, 349 (CCPA 1965).

Claims 2-4 and 9-12 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Pall Housing Data Sheet H25. If it were established that

this reference does not teach integral construction, it would have been obvious to make the components integral. See *In re Larson*, 340 F.2d 965,968; 144 USPQ 347, 349 (CCPA 1965).

Response to Arguments

Applicant's arguments with respect to claims 2-16 and newly added claims 21-25 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 1/2/04 have been fully considered but they are not persuasive.

Regarding the objection to claim 13, Applicant's arguments are not commensurate with the scope of patent protection sought.

Regarding the "omitting essential elements" rejection made under the Second Paragraph of Section 112, Applicant has argued that the elements in question, "(an inlet, an outlet and cartridge filter bores) are inherent in the terms set forth in the claims." This argument is not found persuasive. Absent a later recitation of some of the limitations said to be "inherent," this argument could have been asserted as being plausible. However, such is not the case. Applicant may wish to delete those portions of claim 4 et al. that redundantly recite limitations already present by virtue of inherency.

Ignoring claim 4 et al., Applicant's argument fails to pass muster on two other grounds: Notice and the Prohibition against reading limitations from the specification into the claims. Applicant's argument flies in the face of the Notice

Art Unit: 1724

function. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

Regarding the Section 102 rejections made in view of the Allegheny Bradford Corporation Brochure, Applicant has argued, “As set forth in detail above, Applicants’ multi-round filter housing includes an integrated, one-piece, base assembly including an integral cartridge plate. It is clear from the cited reference that the cartridge is of separate construction, therefore it is not ‘integral’ in the sense that Applicants have discussed above.” This argument is noted, but not found persuasive, since it is not commensurate with the scope of the claims. It is noted that Applicant has underlined the language not found in the claims – for emphasis? Beyond not being commensurate with the scope of the claims, Applicant has failed to provide any probative evidence, rationale, or logic, whatsoever, to support the “clear” conclusion quoted above. The only thing that is clear is that the applied references disclose integrated base assemblies consistent with the definitions set forth in Webster’s Ninth New Collegiate Dictionary (1983) as supplied by Applicant.

Finally, regarding the rejections made under Section 103, Applicant has argued: "The rejections of Claims 1-4 and 9-12 in Paragraphs 11,12 and 13 of the Office Action are moot in light of the above amendments and remarks." This argument has been carefully considered, but is not found to be persuasive.

The balance of the arguments are submitted to be moot in view of the new grounds of rejection.

Any inquiry concerning this communication should be directed to Robert J Popovics at telephone number (571) 272-1164.

A handwritten signature in black ink, appearing to read 'R. J. Popovics', with a large, stylized flourish extending from the end of the signature.

Robert James Popovics
Primary Examiner
Art Unit 1724

November 10, 2004